

60,469-054
OT-4986**REMARKS**

Applicant thanks the Examiner for the remarks and analysis contained in the Office Action. Claims 1-9, 14-24 and 26-42 are pending in this application. Applicant respectfully requests reconsideration of this application.

Applicant respectfully traverses the rejections under 35 U.S.C. §103.

Applicant still submits that the proposed combination of WO 01-14630 and *Kilborn, et al.* does not establish a *prima facie* case of obviousness against claims 1-4, 9, 15-16 and 24. Applicant incorporates the statements from the most recent Response here and submits that the proposed combination cannot be made.

In addition to the reasons already provided by Applicant, the *Kilborn, et al.* reference cannot be used for making an elevator belt as disclosed in the WO 01-14630 reference because it does not provide a technique that is suitable for making the belt of WO 01-14630, in which the cords are imbedded in and spaced from the surfaces of the jacket material. The *Kilborn, et al.* reference requires, for example, that the cords rest on a table and then material is applied to the cords. See, for example, column 5, lines 35-36, 45 and 51-54. Resting the cords on the table will not allow for forming a jacket that is on both sides of the cords as required in the WO 01-14630 reference. The *Kilborn, et al.* reference does not provide a technique that would allow for achieving the intended result of the WO 01-14630 reference and the combination cannot be made.

Additionally, claim 1 requires maintaining a selected tension on each of the cords on an individual cord basis while applying the jacket such that the tension on the cords controls positions of the cords within the jacket. The *Kilborn, et al.* technique relies upon clamps and having the cords lying on the table to control the position of the cords relative

60,469-054
OT-4986

to the material that is applied to those cords while they are on the table. The *Kilborn, et al.* technique does not teach using tension as recited in claim 1 so that even if the combination could be made, the result is not the same as the claimed invention.

Regarding claim 2, the *Kilborn, et al.* reference does not teach maintaining different tensions on different cords. Instead, the *Kilborn, et al.* reference teaches the opposite. At column 1, lines 36-38 (and at line 60), the *Kilborn, et al.* reference teaches, "It is very essential that each of the tension elements should have the same tension while being built into the belt." Using the same tension on every one of the tension elements or cords according to *Kilborn's* teachings is the opposite of what is recited in claim 2 and there is no *prima facie* case of obviousness against that claim.

The Examiner alternatively rejects claim 2 under 35 U.S.C. §103 based upon the proposed combination of the WO 01-14630 reference, the *Kilborn, et al.* reference and the *Nassimbene* reference. The *Nassimbene* reference cannot be added to the proposed combination of the first two references for at least two reasons. First, the *Nassimbene* reference teaches that different lengths and higher tension occur in the middle of *Nassimbene's* arrangement because of its V-shape and the arched belt configuration in that reference. Neither the *Kilborn, et al.* nor the WO 01-14630 reference would allow for such a belt configuration. Therefore, there is no motivation for adding the teachings of the *Nassimbene* reference to the proposed combination of the other two references. Secondly, the *Kilborn, et al.* reference, as just noted, expressly teaches maintaining the same tension on every cord. To add the teachings of the *Nassimbene* reference would be directly contrary to the *Kilborn, et al.* reference and, therefore, the combination cannot be made. There is no *prima facie* case of obviousness against claim 2.

60,469-054
OT-4986

Regarding claim 3, steps are recited for inspecting a sample belt assembly and making an adjustment to tension on at least one cord if a determined configuration is not consistent with a desired configuration. This claim cannot be considered obvious because the *Kilborn, et al.* reference teaches an arrangement where cords are clamped at each end and lie on a table as they are covered with a material. There is nothing within that reference that indicates that the cords would move somehow during the material application such that adjusting a tension on at least one of the cords would change the resulting configuration. Moreover, the *Kilborn, et al.* reference expressly teaches maintaining equal tension on all of the cords so that making an adjustment as recited in claim 3 is contrary to the teachings of the *Kilborn, et al.* reference.

The comments regarding claims 1 and 2 are equally applicable to claims 15 and 16 and there is no *prima facie* case of obviousness against either of those claims.

Regarding claim 24, nothing in either of the WO 01-14630 or the *Kilborn, et al.* reference in any way suggests using a molding device having an opening comprising a non-linear configuration such that a thickness of a jacket exiting the opening varies across a width of the jacket as recited in claim 24. Both of the references expressly teach having a flat belt configuration and nothing in either reference provides any way to accommodate such a molding device nor does it suggest any reason for why such a molding device would be useful with the proposed combination.

When rejecting claims 28, 32 and 36, the Examiner contends that "it is apparent that the cords will inadvertently move while applying the jacket to the cord." Even if that were true, *Kilborn, et al.* does not allow for moving the cords in a direction parallel to a length of the cords while applying the jacket material to the cords (as recited in those

60,469-054
OT-4986

claims). As noted above, the *Kilborn, et al.* reference expressly requires that the cords rest against a table and that they are clamped at each end. Therefore, the cords are stationary in their longitudinal or lengthwise direction during *Kilborn's* process. The cords are not moveable in a direction as recited in claims 28, 32 and 36. That type of movement has no use and appears directly contrary to the intentions of the *Kilborn, et al.* reference. There is no *prima facie* case of obviousness against any of those claims.

Regarding claims 29 and 37, the technique of adjusting the tension on at least one of the cords while applying a jacket material to the cords is again directly contrary to the teachings of the *Kilborn, et al.* reference. In that reference, cords are rested against a table while they are clamped in a fixed position at each end of the cords while material is applied to the cords. All tensions are equal. There is no reason to make such an adjustment on the tension of a cord during a material application portion of *Kilborn's* process. Moreover, the *Kilborn, et al.* reference teaches that groups of cords are clamped in place on the table. It would not be possible to adjust the tension on any one of the cords without adjusting the tension on the entire group because once the clamp is released, *Kilborn's* intended tension would be eliminated. Therefore, one could not accomplish the result of claims 29 or 37 without causing significant problems during *Kilborn's* process. Further, *Kilborn, et al.* teaches removing the weights that are used for tensioning the cords once the cords are clamped in place so that a subsequent adjustment is contrary to those teachings. It can only be the result of hindsight reconstruction to suggest reapplying such a weight for adjusting a tension especially when no adjustment is required according to *Kilborn's* express teaching that an equal tension is maintained on all the cords when they are in the clamped position.

60,469-054
OT-4986

Regarding claim 30, the *Kilborn, et al.* reference teaches applying a material to the cords between the clamps. There is nothing about the *Kilborn, et al.* reference that in any way suggest or would benefit from maintaining the same tension on the cords on opposite sides of the clamps. *Kilborn, et al.* suggests the opposite by leaving any free ends of the cords outside of the clamps without any tension or some minimal tension as a result of the cords extending from the clamp to the spools, for example. There is no *prima facie* case against claim 30. Claims 34 and 38 are not obvious for the same reasons.

Regarding claim 35, *Kilborn, et al.* expressly recognizes that only limited lengths of cords can be worked on at any particular time. Therefore, a continuous and uninterrupted manner of applying a jacket material as recited in claim 35 is not possible according to *Kilborn's* teachings.

Applicant respectfully traverses the rejection of claims 5-7 based upon the proposed combination of WO 01-14630, the *Kilborn, et al.* reference and the *Harper* reference. That combination cannot be made. There is no motivation for adding *Harper's* teaching of a water-soluble barrier material onto a polyurethane to facilitate removing a waxy or oily release agent from a molded polyurethane article. No such mold release agent would be required in *Kilborn's* arrangement. Additionally, the *Harper* reference teaches its arrangement for avoiding a film left on the surface of a molding because of a waxy or oily release agent used during a molding process where the polyurethane article will be subsequently painted. The belts in the WO 01-14630 and *Harper* references are not painted and, therefore, the teachings of the *Harper* reference have nothing to do with the teachings of the other two and there is no benefit for making

60,469-054
OT-4986

their combination. There is no suggestion or motivation from within the art for making that combination.

Moreover, it is not a fair or reasonable interpretation of the *Harper* reference to interpret the contents of the polyurethane used in that reference based upon the discussion of mold release agents applied to a mold used for molding that polyurethane material. The *Harper* reference is silent about the polyurethane material not containing any wax. It is not a reasonable inference to assume that a special, waxless polyurethane would be used when conventional polyurethanes typically include a wax as one of the polyurethane components.

Paragraph 5 of the most recent Office Action indicates that claims 19 and 24 are rejected based upon the WO 01-14630 reference. Applicant assumes that the Examiner intends to combine *Kilborn, et al.* with that reference for purposes of that rejection. Regarding claim 19, there is no *prima facie* case of obviousness because there is none against claim 15 from which it depends. Regarding claim 24, a particular molding device is recited in that claim which is not found in the WO 01-14630 reference. Claim 24 was already discussed above.

Applicant respectfully traverses the rejection of claim 8 based upon the proposed combination of the WO 01-14630 reference, the *Kilborn, et al.* reference and the *Tsai* reference. There is no motivation for adding the teachings of *Tsai* to either the *Kilborn, et al.* reference, the WO references or a combination of them. both of those references require a flat belt configuration. The molding device in *Tsai* is intended to result in an article as shown in Figure 1 of that reference, for example. That is directly contrary to

60,469-054
OT-4986

the teachings of the WO 01-14630 reference and the *Kilborn, et al.* reference. That proposed combination cannot be made.

Applicant respectfully traverses the rejection of claim 14 based upon the proposed combination of the WO 01-14630 reference and the *Harper* reference. Applicant already discussed the *Harper* reference above. The proposed combination cannot be made. There must be some motivation or suggestion from within the art to make the combination and there is nothing in either reference that provides that motivation. The combination cannot be made and there is no *prima facie* case of obviousness against claim 14.

Applicant respectfully traverses the rejection of claims 20 and 26-27 based upon the proposed combination of WO 01-14630 and *Harper*. There is no *prima facie* case of obviousness. As already discussed, there is no motivation for combining the WO 01-14630 and *Harper* references, even if the *Harper* reference could be reasonably interpreted as contended by the Examiner as teaching a waxless polyurethane. Without any motivation for the combination, there is no *prima facie* case of obviousness. As noted above, *Harper's* teachings are intended for an issue that is not present or of any concern in the WO 01-14630 reference because an elevator belt is not painted, for example. Therefore, there is no *prima facie* case of obviousness.

Applicant respectfully traverses the rejection of claims 35 and 39 based upon the proposed combination of the WO 01-14630 reference, *Harper* and the *Pitts, et al.* reference. The *Pitts, et al.* reference could only possibly qualify as prior art, if at all, against Applicant's claims under 35 U.S.C. §102(e). The *Pitts, et al.* reference and Applicant's claimed invention were, at the time the claimed invention was made, owned

60,469-054
OT-4986

by the same person or subject to an obligation of assignment to the same person. The *Pitts, et al.* reference and Applicant's application are commonly owned. Therefore, the *Pitts, et al.* reference cannot be used in an attempt to establish a *prima facie* case of obviousness under 35 U.S.C. §103. That rejection must be withdrawn.

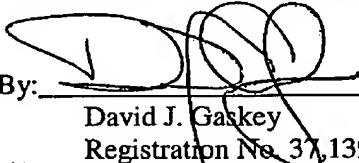
Applicant respectfully submits that new claims 40-42 cannot be considered obvious. In the most recent Office Action, it appears that the Examiner's reasoning for combining the WO 01-14630 and *Harper* references is based in part on the different sized cords used in the WO reference. Claims 40-42 recite an arrangement that is different so that the supposed motivation for combining the references is gone.

Applicant respectfully submits that this case is in condition for allowance.

Applicant believes that additional fees in the amount of \$150.00 are required for three additional claims in excess of twenty. A Credit Card Payment form in the amount of \$150.00 is attached. The Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: 

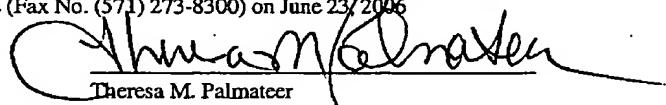
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60,469-054
OT-4986

CERTIFICATE OF FACSIMILE

I hereby certify that this Response relative to Application Serial No. 10/010,937 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on June 23, 2006



Theresa M. Palnateer

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